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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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<input type="checkbox"/>	<input type="checkbox"/>	EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED: 4

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No <b>09/504,741</b>	Applicant(s) <b>Chen</b>
Examiner <b>Michael Meller</b>	Group Art Unit <b>1651</b>

Responsive to communication(s) filed on Sep 11, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11, 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claim

Claim(s) 1-44 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

Claim(s) \_\_\_\_\_ is/are allowed

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 1-44 are subject to restriction or election requirement

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

The proposed drawing correction, filed on \_\_\_\_\_ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d)

All Some\* None of the CERTIFIED copies of the priority documents have been received

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e)

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-27, drawn to a paste formulation, classified in class 424, subclass 94.1.
  - II. Claims 28-31, drawn to a first method of using said paste formulation, classified in class 424, subclass various.
  - III. Claims 32 and 33, drawn to a second method of using said paste formulation, classified in class 435, subclass 183.
  - IV. Claims 34 and 35, drawn to a third method of using said paste formulation, classified in class 435, subclass various.
  - V. Claims 36 and 37, drawn to a fourth method of using said paste formulation, classified in class 514, subclass various.
  - VI. Claim 38, drawn to a fifth method of using said paste formulation, classified in class 435, subclass 184.
  - VII. Claim 39, drawn to a sixth method of using said paste formulation, classified in class 435, subclass various.
  - VIII. Claims 40-43, drawn to a seventh method of using said paste formulation, classified in class 424, subclass various.

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VIV. Claim 44, drawn to a method of making said paste formulation, classified in class 435, subclass 183+.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions VIV and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made in a materially process such as genetic engineering.

3. Inventions I and II-VIII are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the processes for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in many different processes as is evidenced by applicants' own claims.

Inventions II-VIII are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. They each define uses that are patentably distinct from one another.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

The many different therapeutic agents, fumed silicas, viscosity modifiers, carriers, absorbents, etc. which are claimed. Applicant is required to enumerate all of the components to be used in the elected paste formulation. Applicant is also required to be very specific to exactly which therapeutic agent they are using, i.e. if electing a COX-2 inhibitor, specifically which one, i.e. the COX-2 inhibitor of claim 13.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

It is also noted that applicant has included an "Appendix I" at the end of this application. The appendix includes another specification and 11 claims. It is not clear why this is in the application.

Any inquiries concerning this communication should be directed to Examiner Mike Meller at telephone number (703) 308-4230. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Michael Wityshyn, can be reached at (703) 308-4743. The Fax phone number for the art unit is (703) 308-0294. Any inquiries of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

DAVID M. NAFF  
PRIMARY EXAMINER  
ART UNIT 1651